

Gr. 1638

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:) Art Unit: 1638
Heard et al.) Examiner: D. Kruse
Serial No: 09/533,029)
Filed: 3/22/00)
For: Disease-Induced Polynucleotides)

RESTRICTION/ELECTION

Assistant Commissioner of Patents and Trademarks
Patent and Trademark Office
Washington, D.C. 20231

Dear Sir:

The Examiner has restricted the claims to the invention of Group I: claims 1-13 directed to a transformation method and transgenic plant and the invention of Group II: claims 14-16 is directed to a method of selecting sequences.

The Examiner states that the inventions of Group 1 and Group 2 are unrelated, because the inventions are incapable of being used together and they have different modes of operation, different functions or different effects. However, Applicants contend that the inventions in Group I and Group II can be used together. The invention of Group I is directed to a transformation method and transgenic plant containing a sequence. The invention of Group II is directed to a method of selecting sequences. The invention of Group II can therefore be used for the invention of Group I to create transgenic plants. Thus, the Applicants elect the invention of Group I with traverse.

Additionally, the Examiner requests that Applicants elect one family of transcription factors as delineated in the Office Action mailed July 21, 2000. The Examiner states that the sequences of individual families are unrelated.

The Guidelines for the Examination of Patent Applications Containing Nucleotide Sequences states that structurally distinct chemical compounds are presumed to be unrelated to one another. However, if evidence is provided that the sequences are related, the sequences can be examined together. The Guidelines provide examples of

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claims that are subject to the notice. All the claim examples are directed to raw sequence information without any associated functional information.

In the instant patent application, all the sequences are transcription factors and additionally all the transcription factors are induced in plants when the plants are exposed to a pathogen and can be employed to modify the tolerance of plants to pathogens. This is evidence to establish that the sequences are related and that the sequences can be examined together.

Therefore, Applicants contend that all the sequences are related and should be examined at the same time.

Please direct all telephone calls to Karen J. Guerrero at 510-264-0280.

Respectfully submitted,

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Reg. No. 37,071

Date: September 12, 2000

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